

Remarks

Claims 1-20 are pending in this application.

I. Response to Rejections under 35 U.S.C. § 102

A. Legal Standards under 35 U.S.C. § 102

Before discussing rejections based upon 35 U.S.C. § 102, it is believed proper to state that to sustain a rejection under § 102 the Patent and Trademark Office must abide by the following statement of the law.

Under 35 U.S.C. § 102, anticipation requires that each and every element of the claimed invention be disclosed in a prior art reference. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). In addition, the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public. *In re Brown*, 329 F.2d 1006, 1011, 141 USPQ 245, 249 (CCPA 1964).

Akzo N.V. v. U.S. Int'l Trade Comm'n, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986).

B. Analysis

Claims 1-11, 13-17, 19, and 20 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 4,572,038 ("Graham").

Graham basically describes a multi-tip screwdriver, wherein the tips include straight edge screwdriver, Phillips screwdriver, awl, chisel, and socket tips (column 5, lines 17-20). This tool includes a handle 12, a shaft 14 attached to the handle, a cylinder assembly 16 attached to the shaft, and a plurality of tips 18. The tool is designed to have torque, or rotational force, applied to the handle 12, which is directly transmitted to the working tip 18 (column 6, lines 48-50; column 7, lines 22-46).

1. Claim 1

Graham fails to disclose an elongated handle. The handle 12 of Graham is knob-shaped. Graham also fails to disclose an axially extending hole in such handle, wherein punches and setters are slidably mounted. In Graham, the tips 18 are mounted in neck 34 of the cylinder assembly 16. Graham also fails to disclose a second end of the handle adapted to receive an impact force. If an impact force were applied to the handle 12 of Graham, the impact force would hit button 70, which would actuate the spring latch 72 to remove hook 74 from the annular lip 68 of sleeve 66. This would release the sleeve 66 from the spring latch 72, thus permitting the cylinder assembly 16 to slidably move along the shaft 14. Such impact force would also likely damage the button 70, spring latch 72, hook 74, annular lip 68, and/or sleeve 66. Thus, the handle 12 of Graham is not adapted to receive an impact force that would be

transferred to a hole punch or setter. Graham also fails to disclose hole punches and setters. Graham discloses screwdriver tips, awl tips, chisel tips, and socket tips. Thus, Graham fails to disclose each and every element of claim 1.

2. Claim 2

Claim 2 incorporates by reference all of the subject matter of claim 1, which Graham fails to disclose. Graham also fails to disclose an air pressure relief hole in communication with the axially extending hole in the handle. For these reasons, Graham fails to disclose each and every element of claim 2.

3. Claim 3

Claim 3 incorporates by reference all of the subject matter of claim 1, which Graham fails to disclose. Graham also fails to disclose an elongated handle that is substantially cylindrical in shape. The handle 12 of Graham is knob-shaped. For these reasons, Graham fails to disclose each and every element of claim 3.

4. Claim 4

Claim 4 incorporates by reference all of the subject matter of claim 1, which Graham fails to disclose. Graham also fails to a plurality of hole punches, which each comprises a cylindrical shank having a bit at one end. Graham discloses screwdriver, awl, chisel, and socket tips, but no punches. For these reasons, Graham fails to disclose each and every element of claim 4.

5. Claim 5

Claim 5 incorporates by reference all of the subject matter of claim 4, which Graham fails to disclose. Graham also fails to disclose a bit comprising a sharp annular edge for cutting. For these reasons, Graham fails to disclose each and every element of claim 5.

6. Claim 6

Claim 6 incorporates by reference all of the subject matter of claim 5, which Graham fails to disclose. Graham also fails to disclose hold punches comprising a disposal tunnel extending from the sharp annular edge through the cylinder shank to a disposal hole, thereby providing an exit for cut material. For these reasons, Graham fails to disclose each and every element of claim 6.

7. Claim 7

Claim 7 incorporates by reference all of the subject matter of claim 5, which Graham fails to disclose. Graham also fails to disclose hole punches comprising bits of different size. For these reasons, Graham fails to disclose each and every element of claim 7.

8. Claim 8

Claim 8 incorporates by reference all of the subject matter of claim 1, which Graham fails to disclose. Graham also fails to

disclose a plurality of setters, wherein each setter comprises a cylindrical shaft having a bit at one end, such bit adapted to set eyelets. For these reasons, Graham fails to disclose each and every element of claim 8.

9. Claim 9

Claim 9 incorporates by reference all of the subject matter of claim 1, which Graham fails to disclose. Graham also fails to disclose a holder that comprises an O-ring. For these reasons, Graham fails to disclose each and every element of claim 9.

10. Claim 10

Graham fails to disclose an apparatus for storing a handheld combination hole puncher and eyelet setter tool and a plurality of hole punches and setters. Graham merely discloses a cylinder assembly 16 that stores tips 18. Graham also fails to disclose such apparatus where a main hole is adapted to receive the combination tool and maintain it in an upright position. Graham further fails to disclose such apparatus containing a plurality of secondary holes for receiving hole punches and setters. For these reasons, Graham fails to disclose each and every element of claim 10.

11. Claim 11

Claim 11 incorporates by reference all of the subject matter of claim 10, which Graham fails to disclose. Graham also fails to

disclose a transparent cylindrical cover having a closed top and an open bottom. Thus, Graham fails to disclose each and every element of claim 11.

12. Claim 13

Claim 13 incorporates by reference all of the subject matter of claim 10, which Graham fails to disclose. Graham also fails to disclose the apparatus wherein the base is comprised of foam. Therefore, Graham fails to disclose each and every element of claim 12.

13. Claim 14

Claim 14 incorporates by reference all of the subject matter of claim 10, which Graham fails to disclose. Graham also fails to disclose the apparatus wherein the main hole is in the center of the base and the secondary holes are circularly arranged around the main hole. Hence, Graham fails to disclose each and every element of claim 14.

14. Claim 15

Graham fails to disclose a method for installing an eyelet in a piece of material by any means, much less by using a combination hole punch and eyelet setter. Graham also fails to disclose selecting a hole punch and installing it in the combination tool, because Graham fails to disclose hole punches. Further, Graham fails to disclose striking the combination tool with a mallet or

hammer such that the hole punch cuts the material. Still further, Graham fails to disclose interchanging the hole punch with a setter. Further yet, Graham fails to disclose setting the eyelet by striking the combination tool with a mallet or hammer. For these reasons, Graham fails to disclose each and every element of claim 15.

15. Claim 16

Graham fails to disclose a hole puncher and eyelet setter kit comprising a combination hole puncher and eyelet setting tool similar to that described in claim 1 and a storage apparatus similar to that described in claim 10. Thus, Graham fails to disclose each and every element of claim 16.

16. Claim 17

Claim 17 incorporates by reference all of the subject matter of claim 16, which Graham fails to disclose. Further, Graham fails to disclose a transparent cylindrical cover having a closed top and an open bottom. Hence, Graham fails to disclose each and every element of claim 17.

17. Claim 19

Claim 19 incorporates by reference all of the subject matter of claim 16, which Graham fails to disclose. Moreover, Graham fails to disclose a base comprised of foam. For these reasons, Graham fails to disclose each and every element of claim 19.

18. Claim 20

Claim 20 incorporates by reference all of the subject matter of claim 16, which Graham fails to disclose. In addition, Graham fails to disclose a base with a centrally located main hole and secondary holes arranged around the main hole. Thus, Graham fails to disclose each and every element of claim 20.

C. Conclusion

As shown above, Graham fails to disclose each and every element of the invention claimed in claims 1-11, 13-17, and 19-20. For this reason, Graham fails to anticipate these claims. Accordingly, withdrawal of the rejection under 35 U.S.C. § 102(b) over Graham is respectfully requested.

II. Response to Rejections under 35 U.S.C. § 103

A. Legal Standards under 35 U.S.C. § 103

Before responding directly to the issues raised by the Examiner under Section 103, the legal foundation for sustaining such a rejection will be reviewed. Briefly, an applicant for a patent is entitled to the patent unless the application fails to meet the requirements established by law. 35 U.S.C. §§ 102, 103. It is the Patent Office's duty to issue a patent or establish that the applicant is not entitled to a patent under the law. In *re Warner*, 154 USPQ 173, 177 (CCPA 1967), *cert. denied*, 389 U.S. 1057

(1968). Thus, the burden is on the Patent Office to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). If no *prima facie* case of obviousness is established, then a rejection under Section 103 cannot properly be sustained. *In re Oetiker*, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). If the Patent Office establishes a *prima facie* case of obviousness, then the burden of production shifts to the applicant to provide appropriate rebuttal, although the burden of persuasion always remains with the Patent Office. *Id.* Such rebuttal may include arguments, amendments, and/or presentation of objective indicia of nonobviousness. However, such objective indicia are always relevant to a determination of nonobviousness whether or not a *prima facie* case of obviousness has been established. *Stratoflex Inc. v. Aeroquip Corp.*, 218 U.S.P.Q. 871, 879 (Fed. Cir. 1987). To establish a *prima facie* case of obviousness, the Examiner must show all of the limitations of the claimed invention in the prior art. *In re Ehrreich*, 200 U.S.P.Q. 504, 509-11 (C.C.P.A. 1979). The subject matter of the invention must be considered as a whole and through the eyes of a hypothetical person of ordinary skill, not expert skill, in the relevant art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983). References

must also be considered as a whole, including subject matter that teaches away from the invention as well as subject matter that suggests the invention, and not for their isolated teachings. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 227 U.S.P.Q. 657, 669 (Fed. Cir. 1985). References may be combined if there is a suggestion, motivation, or incentive in the prior art to make such a combination. *In re Dillon*, 16 U.S.P.Q.2d 1897, 1901 (Fed. Cir. 1990) (en banc); *In re Jones*, 21 U.S.P.Q.2d 1941, 1943-44 (Fed. Cir. 1992). It is not permissible to use hindsight to pick and choose among isolated teachings in the art after first having read Applicant's application to learn the pattern of the invention. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). Finally, all the facts in evidence are evaluated, and patentability is determined on the totality of the record. *In re Corkill*, 226 USPQ 1005, 1008 (Fed. Cir. 1985). Factual determinations made by the PTO must be based on a preponderance of the evidence, and legal conclusions must be correct. *In re Caveny*, 226 USPQ 1, 3 (Fed. Cir. 1985).

Pursuant to established legal authority, patentability under 35 U.S.C. § 103 requires a four-step analysis, which involves determining (1) the scope and content of the prior art, (2) the differences between the prior art and the claimed inventions, (3) the level of skill in the art, and (4) the objective evidence of

nonobviousness that may have been presented. *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 311, 314 (Fed. Cir. 1983). After all of these factors have been considered, the ultimate legal conclusion on the issue of obviousness must be reached. With the above background in mind the rejections under 35 U.S.C. § 103 will be discussed.

B. Analysis

Claims 12 and 18 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Graham.

1. Claim 12

Claim 12 incorporates by reference all of the limitations of claims 10 and 11. Namely, Graham fails to disclose or suggest an apparatus for storing a handheld combination hole puncher and eyelet setter tool and a plurality of hole punches and setters. Graham merely discloses a cylinder assembly 16 that stores tips 18. Graham also fails to disclose or suggest such apparatus where a main hole is adapted to receive the combination tool and maintain it in an upright position. Graham further fails to disclose or suggest such apparatus containing a plurality of secondary holes for receiving hole punches and setters. Graham also fails to disclose or suggest a transparent cylindrical cover having a closed top and an open bottom. Still further, Graham fails to disclose or

suggest a cover comprising a threaded portion or a base comprising a threaded side wall, wherein the threaded portions of the cover and the base's side wall rotatably engage. Thus, Graham fails to disclose each and every element of claim 12.

2. Claim 18

Claim 18 incorporates by reference each and every limitation of claims 16 and 17. Graham fails to disclose or suggest each and every element of claims 16 and 17, as has been established above. Moreover, Graham fails to disclose or suggest a cover comprising a threaded portion or a base comprising a threaded side wall, wherein the threaded portions of the cover and the base's side wall rotatably engage. Thus, Graham fails to disclose each and every element of claim 18.

C. Conclusion

For the reason that Graham fails to disclose or suggest each and every element of claim 12 and 18, the Office Action fails to establish a *prima facie* case of obviousness. Withdrawal of these rejections is thus respectfully requested.

III. Conclusion

Should the Examiner deem it advisable to conduct a telephone interview for any reason, the undersigned attorney would be most


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agreeable to receiving a telephone call to expedite the prosecution of the application.

For the reasons given above, Applicants respectfully request reconsideration and allowance of Claims 1-20 and passage of this application to issue.

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Respectfully submitted,



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